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Paper No. 36

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(For Patent Owner)

Enclosure: Copy of Requester Petition filed May 6, 2003

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(For Requester)

MAILED

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REEXAM UNIT

Enclosures: Request papers deposited December 26, 2002

In re Campana, Jr. et al.

Request For Reexamination Proceeding

For: U.S. Patent No. 5,436,960 ✓

Deposited¹: April 17, 2003

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: DECISION
: DENYING
: PETITION
:

This is a decision on the May 6, 2003, third party requestor petition under 37 CFR 1.181 for (1) withdrawal of the notice of April 22, 2003,² as improper since jurisdiction is proper, (2) waiver of 37 CFR 1.535(g) and 1.560 to thus permit requestor to participate in a reexamination under 35 U.S.C. 301-307, (3) an order of a Director Initiated Reexamination under 35 U.S.C. 313, and (4) deferral of the effective date for an election required by the April 22, 2003, Notice. The petition is before the Director of the Office of Patent Legal Administration for decision.

¹ The request papers are stated as having been "deposited," as opposed to "filed," since no filing date has been assigned to the papers.

² The April 22, 2003, notice informed requester that the present patent for which *inter partes* reexamination was requested was not eligible for *inter partes* reexamination pursuant to Section 4608 of the American Inventor's Protection Act.

For the reasons set forth below, the petition is denied. In addition, the request papers are being returned to the requester, and the reexamination filing fee submitted with the request papers will be refunded to requester.

REVIEW OF FACTS

1. U.S. Patent No. 5,436,960 (hereinafter, the '960 patent), issued to Campana, Jr. et al., on July 25, 1995, from an application filed on May 20, 1991.
2. On April 17, 2003, the present request for *inter partes* reexamination was deposited in the Office by the third party requester.
3. On April 22, 2003, a notice was issued informing requester that the present patent for which *inter partes* reexamination was requested was not eligible for *inter partes* reexamination (pursuant to Section 4608 of the American Inventor's Protection Act). The notice set a two week period for requester to elect to replace the *inter partes* request for reexamination with an *ex parte* request for reexamination under 37 CFR 1.510, pointing out that if such an election was not received within the two week period, the request papers would be returned to requester.
4. On May 6, 2003, requester filed the instant petition requesting (1) withdrawal of the notice as improper, (2) waiver of 37 CFR 1.535(g) and 1.560 to permit requestor participation in a reexamination under 35 U.S.C. 301-307, (3) a Director Initiated Reexamination under 35 U.S.C. 313, and (4) deferral of the effective date for an election required by the notice.

DECISION

The petition sets forth, at page 1, a request for four types of relief using the conjunction "and" which would appear to indicate that all four types of relief are requested together (i.e., additive grounds). It is, however, clear from the remainder of the petition that the four types of relief requested by petitioner are alternative grounds of relief, and each will be addressed below, in turn, to the extent appropriate.

I. "[W]ithdrawal of the notice of April 22, 2003 as improper since jurisdiction is proper."

The reexamination statute was amended on November 29, 1999, by the 1999 American Inventors Protection Act (AIPA), Public Law 106-113, to expand reexamination by providing an "inter partes" option.³ Section 4608 (effective date) of the AIPA provides:

"(a) In General. - ... this subtitle and the amendments made by this subtitle shall take effect on the date of the enactment of this Act [November 29, 1999] and shall apply to any patent that issues from an original application filed in the United States on or after that date [November 29, 1999]." [emphasis added]

As was pointed out in the April 22, 2003, notice, the application for the patent for which the present reexamination was requested was filed prior to November 29, 1999 (the date of enactment of the AIPA), and, accordingly, the instant patent is not eligible for *inter partes* reexamination.

At pages 4-7 of the present petition, legislative history is presented and discussed with respect to circumstances surrounding the providing of *inter partes* reexamination in the enactment of the AIPA. These circumstances do not change the fact that the legislation was enacted by Congress, and it was signed into law by the President of the United States of America. In addition, while legislative history is useful in interpreting statutory language where the language of the statute is open to interpretation, in the present instance, the plain language of the statute is clear and not ambiguous. The enacted "subtitle and the amendments" made thereby are clearly stated (in Section 4608) to apply "to any patent that issues from an original application filed in the United States on or after" the date of enactment (November 29, 1999). The application for the patent for which the present reexamination was requested was filed prior to that date, and thus is not eligible for *inter partes* reexamination, pursuant to the *clear language* of the statute.

At page 2 of the petition, it is argued that Congress reconsidered Section 4608 of the AIPA, and repealed it "by implication" by way of "at least sections 13106 and 13202 of

³ See Title IV, subtitle F (§§ 4601 through 4608) of the "Intellectual Property and Communications Omnibus Reform Act of 1999," S. 1948 (106th Cong. 1st Sess. (1999)) - Enacted as part of Pub. L. 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999).

Public Law 107-273 ⁴ "[Footnote for the enactment added].

In response, note that Section 13106 of P.L. 107-273 is directed solely to *appeals* in *inter partes* reexamination and expands third party requester rights of appeal in an *inter partes* reexamination proceeding. Further, Section 13202 is directed solely to *appeals* in *ex parte* reexamination and makes statutory technical corrections with respect to same. Neither of Sections 13106 and 13202, nor any other provision of P.L. 107-273, is directed to expanding the eligibility of the pool of patents eligible for *inter partes* reexamination.

Petitioner asserts in the petition that Congress passed the AIPA legislation in haste and did not "substantively consider Section 4608." At page 7 of the petition, applicant states:

"[W]hen the Justice Department Reauthorization Act was considered, since 4608 was not part of Title 35, it is not likely that Congress was anymore aware at the time of the passage in the Justice Department Reauthorization Act, that there were any limitations on the Inter Partes Reexamination practice by virtue of the date on which a patent issued. As a result, Congress granted, in sections 13106 and 13201 of the Justice Department Reauthorization Act a plenary right of appeal to any third party Inter Partes Reexamination requestor apparently under the assumption that participation rights were a given."

With respect to this point, it is to be noted that Congress had ample time to consider and reconsider Section 4608 of the AIPA, before passing H.R. 2215 (the underlying legislation incorporated as part of Title III, Subtitle A (Patent and Trademark Office) of Public Law 107-273), and its precursor bills. Yet H.R. 2215 did not revise the *inter partes* reexamination eligibility provision, while it did, at the same time, revise other reexamination effective date provisions. This shows a clear intent on the part of Congress to retain the *inter partes* reexamination eligibility provision of Section 4608 of the AIPA as-is, i.e., as it was enacted.

It is further to be noted that revision the *inter partes* reexamination eligibility provision was explicitly placed before Congress by way of Section 3(a) of H.R. 2231 introduced by Congressman Lofgren on June 19, 2001, ⁵ and referred to the House

⁴ See the 21st Century Department of Justice Appropriations Authorization Act, TITLE III- INTELLECTUAL PROPERTY, Subtitle A - the "Patent and Trademark Office Authorization Act of 2002" - Enacted as part of Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002).

⁵ 107th CONGRESS, 1st Session

committee.⁶ Yet it was not carried forward in H.R. 2215 which was incorporated into Public Law 107-273. Congress could have chosen to carry forward the substance of Section 3(a) of H.R. 2231, but declined to do so.

In view of the above, the April 22, 2003, notice, is deemed proper, and it will not be withdrawn. The first item of relief requested is accordingly denied.

II. "[W]aiver of 37 C.F.R 1.535(g) and 1.560 to permit Requestor to participate in Reexamination under 35 U.S.C. 301-307."

At pages 9-10 of the petition, requester urges that, if it elects to convert the request deposited April 17, 2003, to a request for ex parte reexamination, 37 CFR 1.535 and 1.560 should be waived pursuant to 37 CFR 1.183 to permit requester to participate in the reexamination proceeding. At page 15 of the petition, it is requested that ex parte reexamination procedure be "expanded by waiver of 37 C.F.R 1.535 and 1.560." This is in effect a petition under 37 CFR 1.183 for waiver of the rules (though it was submitted as a "request").

37 CFR 1.4(c) provides that "each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects." [Emphasis added]

The present request for a waiver of the rules is a distinct "subject" and/or "inquiry," and should have been provided in the form of a separate petition paper under 37 CFR 1.183, accompanied by the petition fee set forth in 37 CFR 1.17(h). Petitioner did not provide the separate petition paper, and did not provide the required petition fee. Accordingly, the issue is not ripe for a decision, and will not be decided herein.

It is, however, pointed out to petitioner that relief by way of a waiver of the rules cannot be provided in this instance, because third party requester participation in an ex parte reexamination is barred by statute, and the statute cannot be waived. Neither the rules nor any provision of the statute provide authority for a third party requester of a reexamination proceeding requested under 35 U.S.C. 302 to file a paper directed to the issues of the reexamination proceeding. *In re Amp*, 212 USPQ 826 (Comr. Pats. 1981). The statute and its intent are clear that a reexamination

⁶ This bill was co-sponsored by Congressman Coble, who introduced the H.R. 1886 *inter partes* reexamination appeal provision which ultimately became Section 13106 of P.L. 107-273 which petitioner advances at page 2 of the petition.

proceeding requested under 35 U.S.C. 302 must be *ex parte*. *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 11 USPQ2d 1866, 1869 (Fed. Cir. 1989) (third parties do not participate before the USPTO).

III. "[T]hat the Patent and Trademark Office order a Director Initiated Reexamination under 35 U.S.C. 313."

At page 15 of the petition, it is stated:

"If neither of the previous requests for relief a granted, Requestor specifically requests that the Director of the Patent and Trademark Office initiate Inter Partes Reexamination under 35 U.S.C. 313 and allow Requestor to participate."

The present request for a Director Initiated Reexamination must be made via a petition under 37 CFR 1.182, since it is for "a question not specifically provided for." While 37 CFR 1.520 provides that the Director may order a reexamination at his initiative, even where a reexamination has not been requested under 37 CFR 1.510 or 1.913, 37 CFR 1.520 does not provide for a member of the public to request that the Director order reexamination at his own initiative. Further, 37 CFR 1.520 does not provide for a Director Initiated *Inter Partes* Reexamination, and there is no 1.900-series rule that does so. Thus, the present request for a Director Initiated Reexamination is clearly for relief "not specifically provided for in the regulations of this part," and such a request must be made via a petition under 37 CFR 1.182.

As noted above, 37 CFR 1.4(c) provides that each distinct subject, inquiry or order must be contained in a separate paper. The present request for a Director Initiated Reexamination is a distinct "subject" and/or "inquiry," and it should have been provided in the form of a separate petition paper under 37 CFR 1.182, accompanied by the petition fee set forth in 37 CFR 1.17(h). Petitioner did not provide the separate petition paper, and did not provide the required petition fee. Accordingly, the issue is not ripe for a decision, and will not be decided herein.

It is, however, pointed out to petitioner that relief by way of a Director Initiated *Inter Partes* Reexamination is not statutorily available to requester. The reference to a Director Initiated Reexamination in 35 U.S.C. 312(a) was explicitly deleted in a technical correction made by Section 13202(a)(2) of Public Law 107-273 (the 21st Century Department of Justice Appropriations

Authorization Act, enacted November 2, 2002).⁷

Accordingly, the reference to "section 312(a)" made in 35 U.S.C. 313 does not include a Director Initiated Reexamination for *inter partes* reexamination.

IV. "[D]eferral of the effective date for an election required by the Notice."

At page 15 of the petition, it is stated:

"The Patents Special Projects Advisor indicated that Requestor must elect whether to pursue Inter Partes Reexamination or elect to convert the Inter Partes Request to an Ex Parte Request by the due date. Since that election cannot be reasonably be made without knowing the outcome of Patent and Trademark Office consideration of his petition and since Requestor has made a contingent election, Requestor requests that the requirement of the Patents Special Projects Advisor be held in abeyance until decision on this Petition is received by Requestor."

The request for a deferral of the effective date for the election required by the Notice must be made via a petition under 37 CFR 1.182, since it is for "a question not specifically provided for." Once again, petitioner has not provided a separate petition paper, nor the required petition fee. Accordingly, the issue is not ripe for a decision. The following is however pointed out to petitioner:

The third party requester has the option to initiate an *ex parte* reexamination of the instant patent by filing a new request for *ex parte* reexamination. Such a filing would not prejudice requestor, as compared to having the present reexamination papers converted at a future time as is requested in the petition. Requester would not be prejudiced because there is no negative consequence that would result from having a later filing date for a reexamination proceeding. Further, the filing fee that accompanied the present request papers is being returned in its entirety, so, requester

⁷ The revision made to 35 U.S.C. 312(a) by P.L. 107-273 is shown as follows in strike-out/underline format:

REEXAMINATION.— Not later than 3 months after the filing of a request for *inter partes* reexamination under section 311, the Director shall determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. ~~On the Director's initiative, and at any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications. The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.~~

does not lose any filing fee applied. Thus, the relief requested by petitioner could be obtained via a different avenue, and there would be no ground for granting a petition under 37 CFR 1.182, even if such had been properly filed.

RETURN OF PAPERS

The notice to requester of April 22, 2003 stated, as its last paragraph:

"The *inter partes* reexamination 'request' papers are being temporarily held in the CRU pending a decision as to whether or not requester wants to replace the *inter partes* request for reexamination with an *ex parte* request for reexamination under 37 CFR 1.510. **If such decision is NOT received within two (2) weeks from the mailing date of this letter, the request papers will be returned to the requester.**"

The instant petition was filed within the two week period; however, an election was not made in the petition.

At page 9 of the petition, a "Conditional Election" is stated as follows:

"...if the Inter Partes Request for Reexamination of eight NTP patents is not granted, applicants elect to convert those Inter Partes Reexamination requests to *ex parte* requests, provided that the provisions of 37 C.F.R. 1.535 (g) and 1.560 are waived to permit requestor participation." [Emphasis added]

A waiver of 37 CFR 1.535(g) and 1.560 has not been granted in this decision; thus, the stated conditional election does not take effect.

In addition, the requested deferral of the effective date for an election required by the April 22, 2003, Notice has not been granted. Accordingly, the request papers are being returned with this decision.

The petition, and the present decision on the petition will be made of record in the patent file.

LACK OF SERVICE

The requisite proof of service (a Certificate of Service) on the patent owner was not included with the instant petition papers. Pursuant to 37 CFR 1.903

"... any document filed by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding in the manner provided in § 1.248. Any document must reflect service or the document may be refused consideration by the Office. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration."

Accordingly, the requester's petition is deficient for failure to reflect service of the response on the patent owner in accordance with 37 CFR 1.903.

Since the requisite proof of service on patent owner has not been included, a copy of the petition is being provided to the patent owner with this decision.

REFUND OF REEXAMINATION FILING FEE

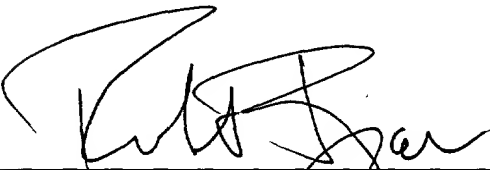
The present deposit of an *inter partes* reexamination was made in error for the reasons set forth above. Pursuant to 35 U.S.C. § 42(d), "[t]he Director may refund any fee paid by mistake...." Accordingly, a refund of the \$8,800 reexamination filing fee will be made to requester in due course by return of the check that was submitted with the request.

THIRD PARTY REQUESTER'S RECOURSE

In the event that the third party requester desires to initiate an *ex parte* reexamination of the instant patent, requester may wish to consider filing a new request for *ex parte* reexamination. Such a filing should include a specific identification of each substantial new question of patentability based on the cited patents and printed publications, as well as a detailed explanation of the pertinency and manner of applying the patents and publications to every claim for which reexamination is requested.

CONCLUSION

1. The third party requestor petition filed May 6, 2003, pursuant to 37 CFR 1.181, is denied.
2. The request papers deposited April 17, 2003, are being returned to the requester with this decision.
3. The requestor petition filed May 6, 2003, and this decision will be made of record in the patent file.
4. A refund of the \$8,800 reexamination filing fee will be made to requester by return of the check that was submitted with the request papers.
5. A copy of the requester petition filed May 6, 2003, is being sent to the patent owner, along with this decision.
6. Telephone inquiries with regard to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at 703-308-6710.



Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

June 3, 2003
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